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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,368	08/23/2006	Jordi Tormo i Blasco	5000-0195PUS1	8390
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BIRCH STEWART KOLASCH & BIRCH			EXAMINER	
PO BOX 747			MOORE, SUSANNA	
FALLS CHURCH, VA 22040-0747				
			ART UNIT	PAPER NUMBER
			1624	
			NOTIFICATION DATE	DELIVERY MODE
			05/22/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/590,368

**Applicant(s)**

BLASCO ET AL.

**Examiner**

SUSANNA MOORE

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/9/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 9/29/06

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on 4/9/2008 is acknowledged. Group I, drawn to [1,2,4-triazolo[1,5-a]pyrimidines and compositions thereof, embraced by claims 1-5, 8 and 9 was elected by Applicant. The traversal is on the ground(s) that the reference provided by the Examiner differs from Applicant's special technical feature. Thus, the following reference, US 4617303, is provided to show Applicant's special technical feature is not a new special technical feature. The requirement is still deemed proper and is therefore made **FINAL**.

There are 10 claims pending and 7 under consideration. Claims 1-5 are compound claims. Claims 8 and 9 are composition claims. Claims 6, 7 and 10 are method claims and currently withdrawn from consideration. This is the first action on the merits. The application concerns some[1,2,4-triazolo[1,5-a]pyrimidine compounds, simple compositions and a seed thereof.

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Substituted [1,2,4]Triazolo[1,5-a]pyrimidines and Their Use for Controlling Harmful Fungi.

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The disclosure is objected to because of the following informalities: Applicant is reminded of the general format accepted for the Specification.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for fungicide-coated seed, does not reasonably provide enablement for a seed in general. The specification does not enable any physician skilled in the art of medicine, to make the invention commensurate in scope with these claims. The how to make requirement of the enablement statute, when applied to process claims, refers to operability and how to make the claimed process work. “The [eight] factors to be considered [in making an enablement rejection] have been summarized as the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in that art, the predictability or unpredictability of the art and the breadth of the claims”, *In re Rainer*, 146 USPQ 218 (1965); *In re Colianni*, 195 USPQ 150, *Ex parte Formal*, 230 USPQ 546. The main issues here are the lack of support for seed, the state of the prior art, and the breadth of the claims.

On page 15, Applicant states seed-dressing. There is also concentration for application on page 17 of the Specification.

There are no working examples of seeds in general. The state of the clinical arts in seeds and fungicides has not been able to incorporate a fungicide into the DNA of a seed.

The scope of the claims involves all of the hundreds of thousands of compounds of claim 1 as well as seeds in general. Thus, the scope of claims is very broad.

MPEP §2164.01(a) states, “A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).” That conclusion is clearly justified here and undue experimentation will be required to practice Applicants' invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Eicken et. al. (US 4617303).

The reference teaches a compound of formula (I) as fungicides, wherein  $R^2 =$  methyl,  $R^1 =$  n-butyl, see column 4, lines 49-50. See also the following compounds, column 5, lines 25-27, column 6, lines 9-10, columns 5-6, table at the bottom of the page, compound 10, columns 7 and 8, table, compounds 25, 34, 36, 38, 40-46 and 48-50. Furthermore, compound 11, columns 7-8, top of the page is wherein  $R^2 =$  methyl,  $R^1 =$  hexyl which is the species found in claim 5, second listed. The compositions are taught in column 8, line 60. Thus, said claims are anticipated by Eicken et. al.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eiken et. al. (US 4617303) in view of Morris et. al.

The instant Application claims compounds as fungicides of formula (I), wherein  $R^2$ = heptyl, octyl, n-nonyl and 1-methyloctyl and  $R^1$ = n-butyl, compositions and seeds thereof.

Eiken et. al. teaches compounds as fungicides of formula (I), wherein  $R^2$ = n-butyl and  $R^1$ = n-butyl, compositions and seeds thereof. See columns 7-8, table, compound 16.

The difference between the claimed compounds and the reference is the substitution at  $R^2$ , n-butyl versus heptyl. Since an n-butyl is a homologue of heptyl these compounds are considered equivalent. The MPEP 2144.09 states "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH<sub>2</sub>- groups) are generally of sufficiently



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close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

Furthermore, the reference teaches the compounds can be prepared as granules, impregnated, by bonding the active ingredient to a solid carrier. A seed can be a solid carrier.

Morris teaches a fungicidal seed dressing, see column 1, line 1. Thus, one of ordinary skill in the art would be motivated to add a fungicide to a seed as taught by Morris in the form of a fungicidal seed dressing.

Thus, claims 4 and 9 are rendered obvious by Eiken et. al. in view of Morris et. al.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re*

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*Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 8 and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 8 and 9 of copending Application No. 10589953. Although the conflicting claims are not identical, they are not patentably distinct from each other because the genera in each Application overlap in scope. Furthermore the species named in claim 4 of the copending Application are homologs of the species claimed in claim 5 of the instant Application. The only difference between these compounds is the carbon counts at R<sup>1</sup> and R<sup>2</sup>. Thus, the copending Application renders the instant Application obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-5, 8 and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 8 and 9 of copending Application No. 10589876. Although the conflicting claims are not identical, they are not patentably distinct from each other because the genera in each Application overlap in scope. Furthermore the species named in claim 5 of the copending Application are homologs of the species claimed in claim 5 of the instant Application. The only difference between these compounds is the carbon counts at R<sup>1</sup> and R<sup>2</sup>. Thus, the copending Application renders the instant Application obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No obviousness-type double patenting rejection over U.S. 7307172 is being made because there is no overlap at R<sup>2</sup>. Thus, the obviousness-type double patenting was considered but not applied. The structural difference between the species of U.S. 7307172 means that the two are patentably distinct.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSANNA MOORE whose telephone number is (571)272-9046. The examiner can normally be reached on M-F 8:00-5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna Moore/  
Examiner, Art Unit 1624

/Brenda L. Coleman/  
Primary Examiner, Art Unit 1624